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In RE:

Application No.:	10/707,489
Filing Date:	December 17, 2003
Inventor:	David M. Kuchar
Title of Invention:	PENNANT TAPE
Confirmation No.:	1488
Attorney Docket No.:	51900-KUCHAR-002
Group Art Unit:	1772
Examiner:	William P. Watkins III
Date Last Office Action:	October 7, 2005

REPLY TO OFFICE ACTION

Dear Sir:

Your Office Action of October 7, 2005 is hereby acknowledged. The original application filed on December 17, 2003 had fifteen claims and eight drawing figures. A preliminary amendment document filed by the Applicant on August 11, 2005 submitted amendments to the specification, and all of the drawing sheets were replaced at that time. No new matter was introduced by the amendments. The claims remained unamended.

PETITION FOR ONE-MONTH EXTENSION OF TIME TO REPLY

Your Office Action specified a three-month shortened statutory period for reply. That period expired on January 7, 2006. Therefore, the Applicant petitions herewith for a one-month extension of time to reply, and submits the appropriate fee.

ACTION BY EXAMINER

At the time of mailing of your Office Action, claims 1-15 were pending in the Present Application. The Examiner rejected claims 1-5, 7 and 12-15. In addition, the Examiner objected to claims 6 and 8-11. The Applicant disagrees with the Examiner's grounds for rejection, and respectfully offers the following arguments by way of traversal.

TRAVERSAL ARGUMENTS

In Paragraph 1 of the Detailed Action Section of your Office Action, the Examiner noted that several of the electronic signatures in the application appear to be improper and not in

accord with 37 CFR § 1.4(d)(3). The Applicant respectfully proffers that the electronic signatures are correct, and refers the Examiner to Ms. Joni Chang at the USPTO Office of Legal Administration. Her phone number is (571)252-7720 and her email address is joni.chang@uspto.gov.

REJECTIONS UNDER 35 U.S.C. § 102

In Paragraph 3 of the Detailed Action Section of your Office Action, the Examiner rejected claims 1-5 and 7 under 35 U.S.C. § 102(b) as being anticipated by Scholl (U.S. 2,633,440) **OR** Udoh (U.S. 5,967,788).

The Examiner stated:

See element Figure 3 of Scholl and Figure 2 of Udoh. Both references show tape type substrates with slits on opposite sides of the tape edges that form pennant and connector portions when the tapes are stretched.

The Present Application has only one independent claim:

1. A tape barrier, display or warning comprising:
 - a tape of flexible material having two generally parallel edges and substantially greater length than width, with cuts made into the tape at selected intervals along the tape defining
 - a) a plurality of pennants, each pennant comprising at least one edge, said pennants alternating with
 - b) a plurality of connecting bands, each band comprising two ends and two edges,wherein each band is connected at one end to one adjacent pennant and at the other end to the other adjacent pennant;
wherein at least a portion of one edge of each band is coincident with at least a portion of an edge of an adjacent pennant; and
wherein at least a portion of either edge of the same band is coincident with at least a portion of an edge of the other adjacent pennant;
such that longitudinal tension on the tape will cause the edges of the bands to separate from the edges of the adjacent pennants, thereby substantially increasing the length of the tape, thus forming a series of spaced apart pennants connected by bands.

The dictionary defines the word **pennant** as follows:

pen•ant¹
n

1. Nautical. A long tapering, usually triangular flag, used on ships for signaling or identification.
2. A flag or an emblem similar in shape to a ship's pennant.
3. Sports. A flag that symbolizes the championship of a league, especially a professional baseball league. The championship symbolized by such a flag.

A second definition is:

Main Entry: **pen•nant**²
Pronunciation: 'pe-n&nt
Function: *noun*
Etymology: alteration of *pendant*

¹<http://www.dictionary.com> (retrieved 02/06/2006)

²Merriam Webster Online - <http://www.merriamwebster.com>

1 a : any of various nautical flags tapering usually to a point or swallowtail and used for identification or signaling **b** : a flag or banner longer in the fly than in the hoist; *especially* : one that tapers to a point
2 : a flag emblematic of championship (as in a professional baseball league); *also* : the championship itself

All of the dictionary definitions define a pennant as a flag. In fact, the Merriam Webster definition 1b defines it as: “a flag or banner longer in the fly than in the hoist,” and further states: “***especially*** one that tapers to a point.”³ The last statement indicates that the usual shape of a pennant is triangular, but that other shapes are permissible. It is apparent from the specification and drawings that in drafting the Present Application, the Applicant intended to use the accepted definition of a pennant as a hanging flag. The drawings show that the preferred shape of the pennant is triangular with the apex pointing downward, but that other shapes, such as rectangular are permissible.

Scholl is entitled: “DOUBLE-FACE ADHESIVE TAPE AND PROTECTIVE COVER THEREFOR.” The specification describes the invention as relating “to improvements in a double-face adhesive tape and a protective cover therefor, the tape being highly desirable for use in connection with the attachment of articles of apparel, make-up devices, and other items to the human body.” An example of its use is shown in FIG. 1 (Scholl) for attaching a brassière cup to a woman’s body which would then be covered by a slip-type garment. The Examiner points to FIG. 3 (Scholl), stating that it shows: “tape type substrates with slits on opposite sides of the tape edges that form pennant and connector portions when the tapes are stretched.” What the figure actually shows is that when stretched, the tape deforms into a zig-zag pattern. No pennants are formed. The tape has transverse slits **12** and **13** each spanning from opposite edges into the center of the tape. When stretched, the zig-zag pattern formed has connectors on both edges of the tape. However, there are no hanging flags as there are in the Present Application. Furthermore, since the tape necessarily has an adhesive backing, one cannot view any accidental formation on the tape as being a hanging flag or pennant.

The Supreme Court stated in *Eibel*⁴, “Accidental results, not intended and not appreciated, do not constitute anticipation in the Patent Law.” The fact that the Examiner himself (and not the inventor) contemplated this configuration after reading the Present Application cannot be the basis for a prior art rejection. The Examiner observed the land on the bottom part of the tape zig-zag in FIG. 3, which is incidentally identical to the land on the top part of the zig-zag, and he interpreted it as “looking like” a pennant. However, this interpretation by the Examiner is prohibited by *Eibel*.

Udoh is entitled: “TOY DEVICE FOR ILLUSTRATING MATHEMATICS.” It is a device made from a flexible material having a series of transverse cuts from either side. FIG. 2 (Udoh) shows the device being deformed into a double zig-zag pattern. First of all, the device disclosed and contemplated by Udoh does not comprise: “a tape of flexible material having ... substantially

³Emphasis supplied

⁴Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U.S. 45, 66, 43 S.Ct. 322,

greater length than width.” Instead, the device has two edges parallel to the transverse cuts to permit deformation. Second, as in Scholl, no pennants are formed. The double zig-zag pattern only has connectors.

In order to establish a *prima facie* case for anticipation, the Examiner must provide:

- a single reference
- that teaches or enables
- each of the claimed elements (arranged as in the claim)
- expressly or inherently
- as interpreted by one of ordinary skill in the art.

Accordingly, an applicant who is able to prove that any one of these elements is not present will effectively prevent the *prima facie* case of anticipation from being established.

Scholl and Udoh can each be treated as a single reference since the Examiner's reference does not inter-relate or combine the references to form the rejection. However, Udoh does not teach a tape having substantially greater length than width. Neither Scholl nor Udoh teaches spaced apart pennants alternating with connectors. Therefore, the Examiner has failed to present a *prima facie* case of unpatentability under 35 U.S.C. § 102(b) based upon anticipation of claim 1 by Scholl or Udoh.

If claim 1 is not anticipated by Scholl nor Udoh, none of the other claims in the Present Application can be anticipated by these references since all of the other claims incorporate the limitations of claim 1 therein. Therefore, none of claims 2-5 nor 7 can be anticipated by Scholl or Udoh. The Applicant respectfully requests that the Examiner reverse his rejection of these claims.

REJECTIONS UNDER 35 U.S.C. § 103

In paragraph 5 of the Detailed Action Section of your Office Action, the Examiner rejected claims 12-15 under 35 U.S.C. § 103(a) as being unpatentable over Scholl or Udoh and further in view of Kuchar (U.S. 5,224,715). The Examiner stated:

Scholl and Udoh teach expandable strips as notes above. Kuchar (co. 2, lines 1-10, element 20) teaches the use of end perforations and partially formed slits to keep a sheet together until final use and prevent tearing. The instant invention claims a tape with slits that are partially formed. It would have been obvious to one of ordinary skill in the art to have formed partial slits and end perforations in the sheets of Scholl and Udoh to prevent the sheet from opening till final use and to prevent tearing.

Kuchar, also the inventor of the Present Application, taught the use of end perforations and partially formed slits to produce hanging flag strips when the tape was pulled horizontally. These perforations keep the tape together and prevent tearing until final deployment. However, while Kuchar is able to be combined with either Scholl or Udoh to perform the same function, Scholl having an adhesive backing does not produce hanging flags or pennants, and Udoh is not a tape with substantially greater length than width and also does not produce hanging flags or pennants. Therefore, the combination does not produce the same invention. This is also apparent from the fact that claims 12-15 depend from claim 1, and therefore incorporate all of the

limitations of claim 1 therein. Claims 12-15 cannot be obvious over the combination of Kuchar with Scholl or Udoh or from Scholl or Udoh alone. If claim 1 is allowable, the rejection of claims 12-15 based upon 35 U.S.C. § 103(a) is improper. The Applicant respectfully requests that the Examiner reverse his rejection of claims 12-15.

CLAIM OBJECTIONS -- ALLOWABLE SUBJECT MATTER

The Examiner objected to claims 6 and 8-11 as being dependent upon a rejected base claim (claims 1 and 7), but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Applicant declines to rewrite the claims at this time based upon the traversal arguments where he believes that the base claims are allowable.

CLAIM AMENDMENTS -- NEWLY PRESENTED CLAIMS

As part of this response, the Applicant introduces two new claims 16 and 17. Claim 16 depends from claim 8 and further defines the repeated series of intervals between the transverse lines. Claim 17 depends from claim 10 and also further defines the repeated series of intervals between the transverse lines. No new matter is introduced.

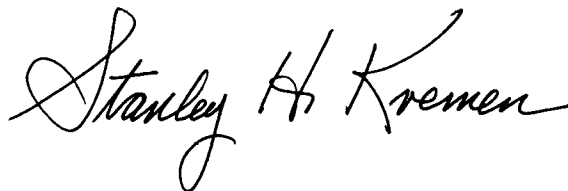
REQUEST FOR ALLOWANCE OF THE APPLICATION

Based upon the traversal arguments presented above, the Applicant respectfully requests that the Examiner reverse his rejections of claims 1-5, 7 and 12-15 based upon 35 U.S.C. §§ 102(b) and 103(a), and requests allowance of the entire application.

APPLICANT'S INTENTION TO PROVIDE A COMPLETE RESPONSE

In preparing this reply to your Office Action, the Applicant intended to provide a complete response to all of the Examiner's rejections and objections. However, if this response is inadvertently insufficient for any reason, the Applicant would appreciate the courtesy of an Advisory Action that would permit him to correct any deficiency.

Respectfully submitted,

A handwritten signature in black ink that reads "Stanley H. Kremen". The signature is written in a cursive, flowing style with a large initial 'S'.

Stanley H. Kremen,
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